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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/060,060	01/28/2002	David Rolf	240.074US1	7158

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EXAMINER

YOUNG, MICAH PAUL

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 12/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/060,060

Applicant(s)

ROLF ET AL.

Examiner

Micah-Paul Young

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-117 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-117 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 – 63, 72 – 101, and 106 -108, drawn to an adhesive patch comprising a backing, cosmetic agent, solvent, a permeation enhancer and a polymer, classified in class 424, subclass 448.
  - II. Claims 64 – 71, drawn to an adhesive patch comprising a backing, cosmetic agent, solvent, permeation enhancer, polymer and sizing agent, classified in class 424, subclass 448.
  - III. Claims 102, and 109 – 111 drawn to adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent, permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.
  - IV. Claims 103, and 112 – 114 drawn to an adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent, permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.
  - V. Claim 104, and 115 – 117 drawn to adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent, permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.

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- VI. Claims 105 drawn to an adhesive mask comprising a two part system comprising a backing and a cosmetic formulation comprising a solvent, permeation enhancer, cosmetic agent, and pressure sensitive adhesive, classified in class 424, subclass 448.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions I and II both recite adhesive patch formulations comprising solvents, cosmetic agents and a backing, yet group II recites the inclusion of a sizing agent, which is not required by the formulation of group I. These two inventions are structurally different because of this and can encompass different utilities.
3. Inventions I, II and III – VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups I and II differ drastically from the remaining groups. I and II are drawn to adhesive patches, themselves distinct from each other, while the remaining groups III – VI are drawn to adhesive facial masks. The adhesive patch formulation of groups I and II do not have to be fashioned in to masks as described by groups II – VI. The patches can be fashioned into many various transdermal delivery systems for various parts of the body. The adhesive patches could also be fashioned or constructed for trans-mucosal delivery as well.

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4. Inventions III and IV – VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups IV – VI are unrelated since the invention of group III. Group III is drawn to an adhesive mask comprising any cosmetic product, while groups IV and V are drawn to specific product, which change the structure, function and utility of the respective masks. Group III differs from VI in that the mask of VI required that the mask be contoured to the face of the individual, while the mask of III is silent to the contouring, and only requires apertures for the eyes and nose. The mask of group III can operate without the contouring required by group VI and therefore structurally a different product.

5.

6. Inventions IV and V – VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions of groups IV and V are unrelated in that they recite different cosmetic agents which all possess different properties. These agents change the function and structure of the masks and therefore produce structurally different products. The invention of group IV is also unrelated to that of VI in that the mask of VI requires the mask to be contoured while IV is silent to this. The mask of group IV can operate without the mask being contoured and provides a structurally different product. Also groups V and VI are unrelated and different for the same reasons as IV and VI are unrelated.

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7. This application contains claims directed to the following patentably distinct species of the claimed invention: *backing polymer*:

- a. Poly-cellulose fibers
- b. Polyester fibers
- c. Polyurethane fibers
- d. Polyolefin fibers
- e. Polyamide fibers
- f. Cotton fibers
- g. Polyurethane
- h. Polyvinyl chloride
- i. Polyethylene
- j. Co-polyester fibers.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 reciting baking polymer is generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: *cosmetic agent*:

- a. Lycopene
- b. Tumeric
- c. Green and white tea
- d. An alpha or beta hydroxyl acid
- e. Vitamins C, E and A

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- f. Collagen synthesis stimulator
- g. Fibroblast growth stimulator
- h. Collagen cross-linking inhibitor
- i. Tourmaline
- j. Caffeine
- k. Theophylline

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 reciting a cosmetic agent is generic.

This application contains claims directed to the following patentably distinct species of the claimed invention: *solvent*:

- a. Polyhydric alcohol
- b. Triacetin
- c. 1,3-propane diol, 2-methyl-1,3-propane diol, glycerol ricinoleate
- d. PEG-6 caprylic / capric glycerides, capric triglycerides, propylene glycol dicaprylate / dicaprate
- e. Glycerol monostearate, monocaprylate, monolaurate
- f. Cholesterol NF, diethylene glycol ethyl ether and acetate
- g. Deoxycholic acid, taurodeoxycholic acid, 3-[(3-cholamidopropyl) dimethylammonio]-1-propane-sulfonate, BigCHAP, cholic acid

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 reciting a solvent agent is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claims, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Micah-Paul Young whose telephone number is 703-308-7005.


The examiner can normally be reached on M-F 7:30am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7648 for regular communications and 703-746-7648 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Micah-Paul Young  
Examiner  
Art Unit 1615

M. Young  
December 4, 2002

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600